

REMARKS

Applicants thank the Examiner for the careful examination of this application.

Claims 1-4 and 6-18 are currently pending in this application. Claims 1 and 2 have been amended. Claim 5 has been canceled. No new claims have been added. A request to withdraw finality of the last Office Action is made.

Request to Withdraw Finality:

Pursuant to MPEP 706(a), a second or subsequent action on the merits may be made final except “where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).”

The Office Action identifies the following as necessitating the new grounds for the rejection and thereby justifying making the Action final: “the limitation ‘carrying a terminal device’.” See, Office Action, page 2. The Applicant respectfully submits that the purported basis for the new ground of rejection is not a newly added limitation and the new ground of rejection was not necessitated by Applicants amendment or an IDS. Regarding when an action may be made final, the MPEP states, as follows:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

See, MPEP, 706.07(a), emphasis added. The appropriate procedure to remedy a premature final rejection is to request reconsideration of the primary examiner, as directed in the MPEP, as follows:

Any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner.

See, MPEP 706.07(c). The MPEP further provides for withdrawal of the final rejections, stating as follows:

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection. * * *

Form paragraph 7.42 should be used when withdrawing the finality of the rejection of the last Office action.

See, MPEP 706.07(d).

In support of their contention that the new ground of rejection was not necessitated by Applicant's amendment, Applicant respectfully submits that the limitation of "carrying a terminal device" has been a claimed element in every independent claims since filing. In support, the Applicant quotes the following from original claims 1, 10, and 12:

Original Claim 1, lines 8-9: "... a terminal device carried by the subject ..."

Original Claim 10, line 6: "... the terminal device is carried by a subject ..."

Original Claim 12, line 9: "... a terminal device carried by the subject ..."

Further, as of the claims set examined that lead to the final office action now alleged to be prematurely made final, the same claims specified as follows:

Claim 1, lines 7-8: "... a terminal device carried by the subject ..."

Claim 10, lines 7-8: "... the terminal device is carried by a subject ..."

Claim 12, line 1, as redrafted: "... a terminal device carried by the subject ..."

Therefore, Applicant respectfully submits that the limitation "carrying a terminal device" was not added to the claims by the amendment, and further, that the new prior art reference to address that limitation, Bridgelall, was not necessitated by Applicant's amendment, and , that the finality of the last Office Action was premature. Accordingly, Applicant respectfully requests that the Primary Examiner withdraw finality of the last Office Action and consider further this Applicant on the merits and as argued below.

Claim Objections Under U.S.C. § 103

Claims 1-3, 5-10, and 12-18 are rejected under 35 U.S.C. § 103(a) as obvious over Moores, U.S. Patent Publication No. 2004/0201738 [hereinafter "Moores"], in view of Bridgelall, U.S. Patent Publication No. 2002/0126013 [hereinafter "Bridgelall"]. Claim 4 is

rejected under 35 U.S.C. § 103(a) as obvious over Moores in view of Bridgelall, and further in view of Muroya, U.S. Patent Publication No. 2004/0148404 [hereinafter “Muroya”]. Claim 11 under 35 U.S.C. § 103(a) as obvious over Moores in view of Bridgelall, and further in view of Zeps, U.S. Patent No. 6,937,154 [hereinafter “Zeps”]. These rejections are respectfully traversed.

Regarding Rejections of Claims 1-3, 5-10, and 12-18:

Claims 1-3, 5-10, and 12-18 are rejected under 35 U.S.C. § 103(a) as obvious over Moores, U.S. Patent Publication No. 2004/0201738 [hereinafter “Moores”], in view of Bridgelall, U.S. Patent Publication No. 2002/0126013 [hereinafter “Bridgelall”].

As the Office Action noted, Moores does not teach the limitation of a terminal device and a RFID tag as a sole terminal device. See, Office Action, page 2. The Office Action further cites to Bridgelall as teaching the missing element – the combination of a wireless communication means, which may in one embodiment be an RFID tag or similar device, and a display means, which may in one embodiment be the screen of a PDA. The Applicant respectfully traverses the rejection noting that Bridgelall fails to teach such a device.

Bridgelall teaches a location system including a host server or computer 32, which is in communication with a series of fixed master devices 12A-C, which fixed master devices detect slave devices 14A-C when such slave devices are within the detection range of the master devices. An example helps clarify the invention, wherein a warehouse may have a host computer to track all pallets of goods, the warehouse has a grid of fixed master devices located around the warehouse, such as next to the light. Attached to the pallets are RFID tags such that when a pallet is moved to within the range of a fixed master device, it will register and the location will be sent to the host computer. When the pallet is moved, the new location is sensed by the new fixed master device, and the new location updated on the host.

Bridgelall teaches to “higher resolution location tracking” by combining Bluetooth® data communications from a portable device and an RFID tag. However, this combination differs significantly from that claimed in the present invention. As taught in Bridgelall, the Bluetooth® device is located by a Bluetooth® reader which is located in the fixed master device along with

the RFID reader. See, Bridgelall, paragraph [0023]. The advantage to adding a RFID tag to a Bluetooth® device is that the Bluetooth® range can be up to 10 meters, and only detectible within a wide range area of a fixed master devices, whereas the RFID tag detection range can go down to 1 foot, and locate the device more accurately within the range of the same fixed master device. See, Bridgelall, paragraphs [0022] and [0024]. Therefore, the location of the combined Bluetooth® device with the RFID tag can result in a higher resolution location tracking” of the device. However, most notably, there is no teaching of a communication by either the host computer or the fixed master device with the Bluetooth® enabled device, and not teaching that the device is capable of receiving images. The Bridgelall invention is a locator system only.

Moore teaches a system wherein an RFID tag may be used to identify a person to store an image of the person and to later access an image of that person from the data storage device. The Office Action cites Moore, paragraph [0047] as teaching “a control means (20) for controlling the drive of the imaging means (15) so that the imaging means (15) is driven to obtain the image data when terminal device carried by the subject (13) and the imaging communication means (34) have become able to communicate with each other, wherein the terminal device carried by the subject (13) comprises a display means for displaying the image data and an integrated subject communication means for wirelessly communicating data, wherein the data includes a unique identification code identifying the terminal device.” See, Office Action, pages 3-4. The Applicant respectfully submits that there are significant distinctions between the claimed invention and the teachings of Moore, paragraph [0047].

Moore, in paragraph [0047] as cited in the Office Action, teaches an embodiment where an RFID scanner is located at the top of a ski slope. A skier’s RFID tag is read by a scanner, but the skier is not photographed at the time the RFID tag is read, but at a later time, if at all. As taught by Moore:

[An] RFID scanner 16 is arranged at the top of a slope, while an image capture device 15 is positioned downhill of the scanner 16. An infrared sensor 51 is arranged to detect a skier breaking an infrared light beam 52 provided by an infrared source 53. In this embodiment, the camera 15 is enabled to capture an image or series of images by detection of a RFID tag carried by a skier, as shown in steps 71, 73, of Fig. 8. The camera 15 is then triggered to take a picture of the skier when the skier breaks the infrared beam or at a selected delay interval thereafter, as shown in step 77.

See, Moores, paragraph [0047].

Therefore, Moores, paragraph [0047], fails to teach or suggest the claimed elements of: “a control means (20) for controlling the drive of the imaging means (15) so that the imaging means (15) is driven to obtain the image data when terminal device carried by the subject (13) and the imaging communication means (34) have become able to communicate with each other.” Moores does not obtain the image data when the terminal device and the imaging communications means have become able to communicate with each other. Rather, Moores, teaches to “enable” the camera to take the skier’s picture when either a set amount of time has passed, presumably in order to allow the skier to get on the slope, or when the skier triggers an infrared beam. Most significantly, the imaging device is not driven when it comes into communication with the terminal device, as claimed at least in the independent claims of the present invention.

Further, as taught in Moores, obtaining the image of the person is not a certainty. Once the camera is “enabled” to take the person’s image, it does not do so until occurrence of a later condition, such as a lapse of time or triggering an infrared sensor. If the later condition is not met, there is no image taken. To the contrary, in the present invention, the sole determinant trigger to obtaining the image is when the “terminal device” comes into communication with the “image device communication means,” such as specified in Claim 1.

As acknowledged in the Office Action, “Moores teaches a PDA (PDA 123) and a RFID tag (RFID tag 20), but not together as one device (Para 19 and 24).” See, Office Action, page 4. The Office Action then cites Bridgelall as teaching the combination of a communications mobile unit and a RFID tag. However, the combination taught in Bridgelall of a Bluetooth® device with an RFID tag is significantly deficient. As discussed above, Bridgelall merely teaches to locate the Bluetooth® device within a range of a master detection device, and then to refine the location within that range by the RFID tag. Bridgelall fails to teach or suggest any communication back to the Bluetooth® device. Further, although Bridgelall teaches the detection of “cell phones” and “PDSs” enabled with Bluetooth® technology, there is no teaching that the cell phones or PDAs

are designed to receive images. There is not inherent or obvious reason for a cell phone or PDA in the invention of Bridgelall to have image capability, because the device is merely located within an area by its communication signal. There is no return communication to the device whatsoever.

The Applicant respectfully submits that the resultant combination of Moores and Bridgelall fails to disclose every claimed feature in independent claims 1, 10, 12, or 18. In order to establish *prima facie* obviousness, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 180 U.S.P.QQ. 580 (C.C.P.A. 1974).

The Federal Circuit has made it very clear that “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *In re Dembiczak*, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999).

Applicant respectfully submits that the Office fails to provide any evidence of a teaching, motivation, suggestion, or rationale that would cause one of ordinary skill in the art to combine Moores and Bridgelall.

The combination of the teachings of Moores and Bridgelall fails to result in the invention claimed in the present Application. Moores teaches identification of a person by the person wearing an RFID tag, and that person may later access photographs of himself or herself using a PDA or similar device. See, Moores, paragraph [0047]. Communication to the system from a PDA is taught in Moores as a separate and independent act that is initiated by the subject. Bridgelall merely teaches to more exactly locate a person using a Bluetooth® device. Combining the teachings of Moores and Bridgelall results in no effective change to the invention of Moores, because it already identifies a person at the effective range of a RFID device. The combination fails to teach or suggest obtaining an image when a “terminal device” carried by a subject and an image device communication means become able to communicate with each other.

Further, the combination fails to teach or suggest a “terminal device carried by the subject comprises a display means for displaying the image data and an integrated subject communication means for wirelessly communicating data.”

Finally, there is no teaching, suggestion, motivation, or rationale for combining the two references. Moores teaches a camera system “enabled” by a RFID tag. Bridgelall teaches more exact location of a person using a Bluetooth® enabled device by also using a RFID tag reader. The “higher resolution” of location taught in Bridgelall is created by using a RFID tag to further focus the Bluetooth® device location. Bridgelall teaches nothing of communicating back to the Bluetooth® device, but merely to locate it. Further, Bridgelall teaches nothing of communicating images, sound, or anything back to the Bluetooth® device at any time, and does not even require that the Bluetooth® device have image capabilities. Moores already teaches to use a RFID tag, so Moores inherits nothing from the teachings of Bridgelall to narrow the range by using a RFID tag. Again, there is no teaching, suggestion, motivation, or rationale to translate the technique of locating Bluetooth® devices with RFID tags to combining RFID tags with portable image devices such that images triggered by the means including RFID tags may be communicated to the portable imaging device.

Regarding Rejection of Claims 4 and 11:

Applicant respectfully submits that dependent Claims 4 and 11 are allowable at least based on the allowability of the independent claims from which they depend.

CONCLUSION

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael K. Mutter, Reg. No. 29,680 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/727,546
Amendment dated December 26, 2007
After Final Office Action of September 25, 2007

Docket No.: 2091-0302P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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